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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,932	03/19/2004	Tohru Ishitani	H6808.0002/P002-A	6731
24998	7590	10/01/2004	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			TERESINSKI, JOHN	
2101 L STREET NW			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20037-1526			2858	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/803,932

Applicant(s)

ISHITANI ET AL.

Examiner

John Teresinski

Art Unit

2858

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on IDS filed 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/19/2004, 9/1/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group1, claims 11-17 in the reply filed on September 13, 2004 is acknowledged. The traversal is on the ground(s) that claims 18 and 19 do not present a serious burden. This is not found persuasive because searching for the claimed subject matter of determining that there is continuity based on luminance signal intensity compared to a threshold would provide undue burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 18 and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 13, 2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11 and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,452,174 to Hirose et al..

Art Unit: 2858

Regarding claim 11, Hirose et al. disclose a sample chamber (50), a movable sample stage (6) for holding a device sample inside the sample chamber (column 8 lines 36-41), a charged particle beam generator (1) for irradiating the sample held by the sample stage with a charged particle beam (column 6 lines 22-27), a charged particle detector for detecting a secondary charged particle generated from the sample as it is irradiated with the charged particle beam (column 5 lines 66-67), an image display for displaying an observation image based on the detection of the secondary charged particle by the charged particle detector (column 1 lines 45-63), a conductor probe to be brought into contact with the sample (column 3 lines 17-30) and a conductor probe transport mechanism for transporting the conductor probe, wherein the image display displays a position mark indicating the tip of the conductor probe (column 1 lines 55-63).

Regarding claim 14, Hirose et al. disclose the position mark is displayed differently depending on whether the conductor probe is in contact with the surface of the sample or not (column 1 lines 45-63).

Regarding claims 15 and 16, Hirose et al. disclose the image display displays a recorded image based on the detection of the charged particle beam, wherein the position mark is superposed on the recorded image and transport means for transporting the position mark on the image (column 1 lines 45-63).

Regarding claim 17, Hirose et al. disclose selecting the mark (column 1 lines 53-56).

Claim Rejections - 35 USC § 103

Art Unit: 2858

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al..

Regarding claim claims 12 and 13, Hirose et al. discloses the claimed invention except for a plurality of conductor probes and a plurality of probe transport mechanisms. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a plurality of conductor probes and a plurality of probe transport mechanisms for the purpose of contacting multiple probe sites and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Teresinski whose telephone number is (571) 272-2235. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le can be reached on (571) 272-2233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2858

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ST
JT

September 24, 2004



N. Le
Supervisory Patent Examiner
Technology Center 2800